

REMARKS

Claims 39-55 stand rejected and remain pending. Claims 39 and 53-55 have been amended herein to recite that the sum of the number of nucleotides of the first and second arms is from 25 nucleotides to 53 nucleotides. Support for this amendment can be found in Applicants' specification at, for example, page 36, lines 4-8, and Figure 3. Thus, no new matter has been added.

In light of the above amendments and the following remarks, Applicants respectfully request reconsideration and allowance of claims 39-55.

Rejections under 35 U.S.C. § 112, first paragraph

The Examiner rejected claims 39-55 under 35 U.S.C. § 112, first paragraph, as lacking written description. In particular, the Examiner stated that the phrase, "wherein the sum of the number of nucleotides of said first and second arms is 25 nucleotides or more," is considered new matter because there is no support for a ribozyme construct where there is no upper limit on the number of nucleotides comprised within the first and second arms or the construct.

Applicants respectfully disagree. To further prosecution, however, the claims have been amended herein to recite that the sum of the number of nucleotides of said first and second arms is from 25 nucleotides to 53 nucleotides. Applicants' specification describes autocatalytically cleaving ribozymes having arms where the sum ranges from 25 to 53 nucleotides. See, *e.g.*, page 36, lines 4-8 and Figure 3. Thus, the Applicants' specification adequately describes the invention of claims 39-55 as amended, and no new matter has been added.

The Examiner also rejected claims 40-41 under 35 U.S.C. § 112, first paragraph, as lacking written description. Specifically, the Examiner stated that other than the structures defined in SEQ ID NO:5 and Figure 3, or Figure 4, it is unclear what other nucleotide structures define a pCHOP cassette or a pSNIP cassette.

Applicants respectfully disagree. Applicants' specification adequately describes structures for a pCHOP and a pSNIP cassette. A structure of a pCHOP cassette is set forth in Figure 3, and in Figure 4 as part of a pSNIP cassette. A structure of a pSNIP cassette is set forth

in Figure 4. Thus, Applicants' specification fulfills the requirement for written description of a pCHOP cassette and a pSNIP cassette.

In light of the above, Applicants respectfully request withdrawal of the rejection of claims 39-55 under 35 U.S.C. § 112, first paragraph.

Rejections under 35 U.S.C. § 101

The Examiner rejected claim 53 under 35 U.S.C. § 101 as being drawn to non-statutory subject matter. In particular, the Examiner stated the term "host cell" is readable on a human being.

Applicants respectfully disagree. Claim 53 has been amended to recite "an isolated cell," and thus, is clearly not drawn to non-statutory subject matter.

In light of the above, Applicants respectfully request the withdrawal of the rejection of claim 53 under 35 U.S.C. § 101.

Rejections under 35 U.S.C. § 102(a)

The Examiner rejected claims 39, 43-48, 50-51, and 53-55 under 35 U.S.C. § 102(a) as being anticipated by Norris *et al.* (WO98/24925).

Applicants respectfully submit that the accompanying declarations filed under 37 C.F.R. § 1.131 demonstrate Applicants' prior completion of multiple species, which put Applicants in possession of the claimed genus prior to June 11, 1998 (the international publication date of WO 98/24925). In light of this evidence, Applicants respectfully request withdrawal of the rejections of claims 39, 43-48, 50-51, and 53-55 under 35 U.S.C. § 102(a).

Applicant : James S. Norris et al.
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Filed : February 26, 2002
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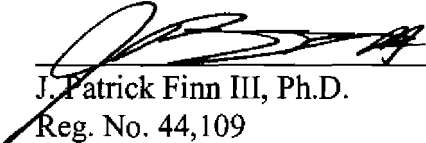
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CONCLUSION

Applicants submit that claims 39-55 are in condition for allowance, which action is respectfully requested. Please charge Deposit Account No. 06-1050 for the Extension of Time fee. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: June 25, 2007



J. Patrick Finn III, Ph.D.
Reg. No. 44,109

Fish & Richardson P.C.
60 South Sixth Street
Suite 3300
Minneapolis, MN 55402
Telephone: (612) 335-5070
Facsimile: (612) 288-9696